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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,234	10/14/2003	Bin Zhu	MSI-1753US	4625
22801	7590	10/06/2008		
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			EXAMINER HENEGHAN, MATTHEW E	
			ART UNIT	PAPER NUMBER
			2439	
			MAIL DATE	DELIVERY MODE
			10/06/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/685,234

**Applicant(s)**

ZHU ET AL.

**Examiner**

MATTHEW HENEGHAN

**Art Unit**

2139

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,6-9,11,22-24,28,31,32,43,46,47 and 49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-9,11,22-24,28,31,32,43,46,47 and 49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 22 July 2008 has been entered.
2. In response to the previous office action, Applicant has amended claims 2, 6, 22, 31, and 43 and added claim 49. Claims 1, 2, 6-9, 11, 22-24, 28, 31, 32, 43, 46, 47, and 49 have been examined.
3. Applicant's request for an interview has been noted; however, an interview is not a matter of right until after the mailing of this office action and it does not appear that the outstanding new matter issues could have been resolved in this manner at this time. No interview call was therefore made.

***Response to Amendment***

4. In the amendment to the claims filed 22 July 2008, all of the dependent claims (except claim 6) are recited as being dependent upon claim 0, which does not exist. It is being presumed that all claims are dependent on the same claims as in the previous versions of the claims.

5. The affidavit under 37 CFR 1.132 filed 6 November 2007 is insufficient to overcome the rejection of former claim 5 et al. (now claim 1 et al.) based upon 35 U.S.C. 112, first paragraph, as set forth in the last Office action because Min Feng's explanations do not adequately establish that the changes to the specification filed 25 November 2003 are substantially equivalent to that which was disclosed in the original specification.

Regarding Change A, Min Feng's explanations are based in part on the assertion that  $N$  is a compound number; however, this property is not disclosed in the specification. Even if this were the case, Min Feng's fails to establish that one skilled in the art would necessarily replace  $N$  with  $\Phi(N)$ . It has not been established by these arguments that Change A does not constitute new matter.

Regarding the first change in Change B, since Min Feng appears to admit that  $g\in Z_n$  and  $g\in Z_n^*$  are acceptable alternatives to one another, the change to  $g\in Z_n^*$  must be construed as new matter.

Regarding the second change in Change B and Changes C and D, the argument concerning the addition of mod  $N$  to equations (4), (7), and (8) is persuasive.

Regarding Change E, Min Feng admits that the change is not appropriate for the situation and the argument is therefore not persuasive.

6. The amendment filed 25 November 2003 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendment to the specification includes several changes to previously presented equations.

Applicant is required to cancel the new matter in the reply to this Office Action.

7. The amendment filed 22 July 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendment to paragraph 75 is new matter because one skilled in the art would not necessarily recognize that  $N$  should be replaced with  $\Phi(N)$ . Applicant's argument that this change does not constitute new matter is further found to not be persuasive for the same reason as Change E, above.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Objections***

8. Claim 49 is objected to because of the following informalities: In lines 6-7, the term "a partial licenses" makes no sense. It is presumed that the term should be "a partial license." Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1, 2, 6-9, 11, 22-24, 28, 31, 32, 43, 46, and 47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 22, and 43 each incorporate new matter into the equations that were introduced in the amendment filed 25 November 2003 and which have not been overcome by Applicant's arguments and affidavit.

Claim 31 incorporates new matter into the equations that were introduced in the amendment filed 22 July 2008 and which have not been overcome by Applicant's arguments and affidavit.

Claims 2, 6-9, 11, 23, 24, 28, 32, 46, and 47 depend from rejected claims 1, 22, 31, and 43 and include all the limitations of those claims, thereby rendering those dependent claims as failing to comply with the written description requirement.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 49 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0109707 to Lao et al.

Lao discloses a clearinghouse system in which users are issued licenses (a rights label) having decryption keys and access rules (rights) (see paragraph 30). Lao also discloses an offering of a plurality of time durations in exchange for various monetary amounts (see paragraphs 43 and 46). The user responds by indicating the exercising of an offered right (see paragraph 35) and the user is then authorized (licensed) by the clearinghouse to play the content (see paragraph 30).

***Allowable Subject Matter***

11. Claims 1, 2, 6-9, 11, 22-24, 28, 31, 32, 43, 46, and 47 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112, 1st paragraph, set forth in this Office action for the reasons stated regarding claims 5, 6, 27, and 48 in the previous office action.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached at (571) 272-4063.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for



published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Matthew Heneghan/

Primary Patent Examiner, USPTO AU 2139

October 8, 2008